



REMARKS/ARGUMENTS

Claims 1-18 are active in this application.

The present invention relates to a toner for electrophotography comprising a binder resin, a charge control agent and a colorant. The colorant is required to be a black iron oxide compound containing from 10% by weight to 45% by weight of titanium component in terms of Ti atom in relation to Fe atom (as measured by wavelength dispersive X-ray fluorescence spectrometry). Further, the colorant is required to have peaks at Bragg angle  $2\theta$  to CuK $\alpha$  X-ray of peak A at 32.9 degrees  $\pm$  0.3 degrees and peak B at 35.5 degrees  $\pm$  0.3 degrees, with an intensity ratio of peak A/peak B in the range of 0.3 to 2.0 at a scan speed of 0.5 degrees/min to 4 degrees/min.

Claims 1-8 stand rejected under 35 U.S.C. 102(b) or under 35 U.S.C. 103 over Shimo et al. Firstly, Applicants note that Shimo et al is not available as prior art under 35 U.S.C. 102(b), but rather only under 35 U.S.C. 102(e), as it was filed in the US on October 17, 2003, less than one year prior to Applicant's US filing date of March 16, 2004. Further, the Shimo et al reference did not publish until July 8, 2004, after Applicant's US filing date.

Secondly, Applicants provide herewith a certified translation of the Japanese priority document of the present application, having a filing date of March 17, 2003, prior to the effective prior art date of Shimo et al. Since Applicants have now perfected their claim to priority, Shimo et al is not available as effective prior art against the present application, and the rejection should therefore be withdrawn.

Claims 1-18 stand rejected under 35 U.S.C. 103(a) over Tosaka et al, in view of Katamoto and Aoki et al. Applicants note that Tosaka et al (US 6,969,574) is only available as prior art under 35 U.S.C. 102(e), as it was filed prior to Applicants' US filing date, but did not publish until it issued on November 29, 2005, **after** the present application filing date. Further, Applicants note that Tosaka et al is assigned to Ricoh Company, Ltd., the same

assignee as in the present application. Thus, according to 35 U.S.C. 103(c), Tosaka et al is not available as prior art for rendering the present invention obvious.

While the Examiner has stated that Katamoto teaches a black pigment that has the x-ray diffraction pattern and Ti/Fe ratio required in the present claims, the Examiner is mistaken. The only description or mention of x-ray diffraction is in Figure 2, which contains no peak B at 35.5 degrees  $\pm$  0.3 degrees, as required by the present claims. Additionally, the A/B peak ratios are nowhere close to the required range of the present invention, as Katamoto's A peaks are minuscule relative to their corresponding B peaks. Clearly the black pigment being referred to by Katamoto is not the same as the present invention colorant.

Aoki et al has been used by the Examiner merely to teach a general apparatus and image forming method that could use any colorant. Accordingly, even if one combines Katamoto and Aoki et al, the combination of references cannot suggest the present invention toner and the rejection should be withdrawn.

The Examiner has objected to the information disclosure statement filed July 28, 2004 on the grounds that it does not comply with 37 CFR 1.98(a)(3) as it does not include a concise explanation of the relevance of each patent listed. However, the Examiner has misread 37 CFR 1.98(a)(3). This section of the regulations states:

“A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language...” (emphasis added)

Accordingly, the only references that require a statement of relevance are those that are not in English. Since every reference listed in the IDS filed July 28, 2004 was either a US patent, a published US application, or a pending US application yet to be published, and all of these are in English, no explanation of relevance is required. As such, the Examiner is

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requested to consider each of the references listed in the IDS and statement of related cases filed.

Applicants submit that the application is now in condition for allowance and early notification of such action is earnestly solicited.

Respectfully submitted,

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